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Commissioner for Patents,  
Alexandria, VA 22313-1450

On

By

Michelle Steery

PATENT  
Attorney Docket No.: C-6-2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Philip E. Eggers, et al.

Application No.: 09/054,660

Filed: April 3, 1998

For: **SYSTEMS AND METHODS FOR  
ELECTROSURGICAL MYOCARDIAL  
REVASCULARIZATION**

Examiner: M. Peffley

Art Unit: 3739

Confirmation No.: 2890

**SUPPLEMENTAL INFORMATION  
DISCLOSURE STATEMENT UNDER  
37 CFR §1.97 and §1.98**

Commissioner for Patents  
Alexandria, VA 22313-1450

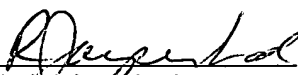
Sir:

The references cited on attached form PTO-1449 are being called to the attention of the Examiner. A copy of each is enclosed.

It is respectfully requested that the cited information be considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue there from.

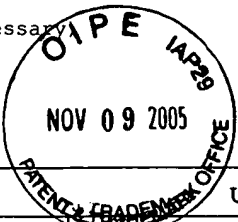
This IDS is being filed after the mailing date of the first Office Action and after three months of the filing date, but prior to the Notice of Allowance or Final Office Action. The Commissioner is authorized to charge the required fee to Deposit Account No. 50-0359.

Respectfully submitted,

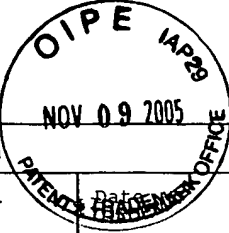
  
Raj Jaipershad  
Reg. No. 44,168

Nov 7/05  
Date

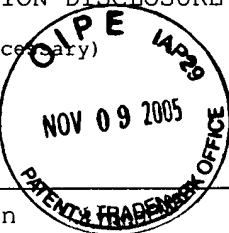
ArthroCare Corporation  
680 Vaqueros Ave.  
Sunnyvale, CA 94085-3523  
(408) 736-0224

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|--|---|----------|---|-------|---|----------------------|
| FORM PTO-1449 (Modified)<br><br>LIST OF PATENTS AND PUBLICATIONS FOR<br>APPLICANT'S INFORMATION DISCLOSURE<br>STATEMENT<br>(Use several sheets if necessary) |   |          | Attorney Docket No.<br><br><b>C-6-2</b> |       | Application No.:<br><br><b>09/054,660</b> |                      |
|   |   |          | Applicant: <b>Philip E. Eggers</b>      |       |   |                      |
|  |   |          | Filing Date:<br><b>04/03/1998</b>       |       | Group: <b>3739</b>                        |                      |
| Reference Designation  |   |          | U.S. PATENT DOCUMENTS                   |       |   |                      |
| Examiner Initial   | Document No.  | Date     | Name                                    | Class | Sub-class                                 | Filing Date          |
|  |   |          |   |       |   |                      |
| FOREIGN PATENT DOCUMENTS   |   |          |   |       |   |                      |
|  | Document No.  | Date     | Country                                 | Class | Sub-class                                 | Translation (yes/no) |
| ___ AN   | 57-57802  | 04/05/82 | JP                                      | A61B  | 1/00                                      |                      |
| ___ AH   | 97/48345  | 12/24/97 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ AI   | 98/27880  | 07/02/98 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ AB   | 92/21278  | 12/10/92 | WIPO                                    | A61B  | 5/04                                      |                      |
| ___ AC   | 94/08654  | 04/28/94 | WIPO                                    | A61M  | 37/00                                     |                      |
| ___ AD   | 97/00647  | 01/09/97 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ AE   | 97/00646  | 01/09/97 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ AJ   | 2 327 350   | 01/27/99 | UK                                      | A61B  | 17/39                                     |                      |
| ___ AK   | 2 327 351   | 01/27/99 | UK                                      | A61B  | 17/39                                     |                      |
| ___ AL   | 2 327 352   | 01/27/99 | UK                                      | A61B  | 17/39                                     |                      |
| ___ AA   | 0 694 290   | 11/15/00 | Europe                                  | A61B  | 18/04                                     |                      |
| ___ AF   | 0 703 461   | 03/27/96 | Europe                                  | G01R  | 27/02                                     |                      |
| ___ AG   | 0 754 437   | 01/22/97 | Europe                                  | A61B  | 17/39                                     |                      |
| ___ AM   | 3930451   | 03/21/91 | Germany                                 | A61B  | 17/39                                     |                      |
| OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)   |   |          |   |       |   |                      |
| ___ AO   | Pearce, John A. (1986) <i>Electrosurgery</i> , pgs. 17, 69-75, 87, John Wiley & Sons, New York. |          |   |       |   |                      |
| ___ AP   | J.W. Ramsey et al. <i>Urological Research</i> Vol. 13, pp. 99-102 (1985).                       |          |   |       |   |                      |
| ___ AQ   | V.E. Elsasser et al. <i>Acta Medico Technica</i> Vol. 24, No. 4, pp. 129-134 (1976).            |          |   |       |   |                      |
| ___ AR   | P.C. Nardella (1989) <i>SPIE</i> 1068:42-49<br>Radio Frequency Energy and Impedance Feedback    |          |   |       |   |                      |
| ___ AS   | R. Tucker et al., Abstract P14-11, p. 248, "A Bipolar Electrosurgical Turp Loop"                |          |   |       |   |                      |
| ___ AT   | R. Tucker et al. <i>J. of Urology</i> Vol. 141, pp. 662-665, (1989).                            |          |   |       |   |                      |
| ___ AU   | R. Tucker et al. <i>Urological Research</i> Vol. 18, pp. 291-294 (1990).                        |          |   |       |   |                      |
| ___ AV   | Kramolowsky et al. <i>J. of Urology</i> Vol. 143, pp. 275-277 (1990).                           |          |   |       |   |                      |
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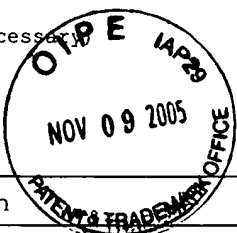
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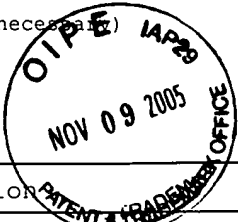
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|   |   |          | Applicant: <b>Philip E. Eggers</b>      |       |   |                      |
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| <b>FOREIGN PATENT DOCUMENTS</b>  |   |          |   |       |   |                      |
|  | Document No.  | Date     | Country                                 | Class | Sub-class                                 | Translation (yes/no) |
| ___ BK   | 57-117843   | 07/22/82 | JP                                      | A61B  | 17/39                                     |                      |
| ___ BL   | 99/51158  | 10/14/99 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ BM   | 99/51155  | 10/14/99 | WIPO                                    | A61B  | 17/36                                     |                      |
| ___ BF   | 97/48346  | 12/24/97 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ AW   | 95/34259  | 12/21/95 | WIPO                                    | A61F  | 5/48                                      |                      |
| ___ BN   | 98/27879  | 07/02/98 | WIPO                                    | A61B  | 17/36                                     |                      |
| ___ BE   | 97/24994  | 07/17/97 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ BD   | 97/24993  | 07/17/97 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ BO   | 97/24074  | 07/10/97 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ BC   | 97/24073  | 07/10/97 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ AX   | 93/13816  | 07/22/93 | WIPO                                    | A61B  | 17/36                                     |                      |
| ___ AY   | 90/07303  | 07/12/90 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ BG   | 98/07468  | 02/26/98 | WIPO                                    | A61N  | 1/40                                      |                      |
| ___ AZ   | 94/04220  | 03/03/94 | WIPO                                    | yes   | A61N                                      |                      |
| ___ BB   | 96/00042  | 01/04/96 | WIPO                                    | A61B  | 17/39                                     |                      |
| ___ BH   | 2 308 979   | 07/16/97 | GB                                      | A61B  | 17/36                                     |                      |
| ___ BI   | 2 308 980   | 07/16/97 | GB                                      | A61B  | 17/36                                     |                      |
| ___ BJ   | 2 308 981   | 07/16/97 | GB                                      | A61B  | 17/36                                     |                      |
| ___ BA   | 0 740 926 A2  | 11/06/96 | EP                                      | A61B  | 17/39                                     |                      |
| <b>OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)</b>  |   |          |   |       |   |                      |
| ___ BP   | Kramolowsky et al. <i>J. of Urology</i> Vol. 146, pp. 669-674 (1991).                 |          |   |       |   |                      |
| ___ BQ   | Slager et al. <i>Z. Kardiol.</i> 76:Suppl. 6, 67-71 (1987).                           |          |   |       |   |                      |
| ___ BR   | Slager et al. <i>JACC</i> 5(6):1382-6 (1985).   |          |   |       |   |                      |
| ___ BS   | Olsen MD, Bipolar Laparoscopic Cholecstectomy Lecture (marked confidential), 10/07/91 |          |   |       |   |                      |
| EXAMINER   |   |          | DATE CONSIDERED                         |       |   |                      |

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|   |  |          | Applicant: <b>Philip E. Eggers</b>   |       |  |                      |
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| ___ BU1  | 93/20747   | 10/28/93 | WIPO   | A61B  | 5/00   |                      |
| ___ BT   | 90/03152   | 04/05/90 | WIPO   | A61B  | 17/39  |                      |
| ___ BU   | 2313949  | 01/07/77 | France   | A61N  | 3/02   |                      |
| OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)   |  |          |  |       |  |                      |
| ___ BV   | Codman & Shurtleff, Inc. "The Malis Bipolar Electrosurgical System CMC-III Instruction Manual" 7/1991  |          |  |       |  |                      |
| ___ BW   | Valley Forge's New Products, CLINICA, 475, 5, 11/6/91  |          |  |       |  |                      |
| ___ BX   | Valley Forge Scientific Corp., "Summary of Safety and Effective Information from 510K," 1991   |          |  |       |  |                      |
| ___ BY   | Codman & Shurtleff, Inc. "The Malis Bipolar Coagulating and Bipolar Cutting System CMC-II" brochure, early 1991  |          |  |       |  |                      |
| ___ BZ   | L. Malis, "The Value of Irrigation During Bipolar Coagulation" See ARTC 21602, early 4/9/93  |          |  |       |  |                      |
| ___ CA   | L. Malis, "Excerpted from a seminar by Leonard I. Malis, M.D. at the 1995 American Association of Neurological Surgeons Meeting," 1995   |          |  |       |  |                      |
| ___ CB   | L. Malis, "Electrosurgery, Technical Note," <i>J. Neursurg.</i> , Vol. 85, 970-975, 11/96  |          |  |       |  |                      |
| ___ CC   | Ian E. Shuman, "Bipolar Versus Monopolar Electrosurgery: Clinical Applications," <i>Dentistry Today</i> , Vol. 20, No. 12, 12/01   |          |  |       |  |                      |
| ___ CD   | Protell et al., "Computer-Assisted Electrocoagulation: Bipolar v. Monopolar in the Treatment of Experimental Canine Gastric Ulcer Bleeding," <i>Gastroenterology</i> Vol. 80, No. 3, pp. 451-455 |          |  |       |  |                      |
| ___ CE   | Cook and Webster, "Therapeutic Medical Devices: Application and Design," 1982  |          |  |       |  |                      |
| ___ CF   | Valleylab SSE2L Instruction Manual, 1/6/83   |          |  |       |  |                      |
| ___ CG   | Robert D. Tucker et al., "Demodulated Low Frequency Currents from Electrosurgical Procedures," <i>Surgery, Gynecology and Obstetrics</i> , 159:39-43, 1984                                       |          |  |       |  |                      |
| ___ CH   | Lu, et al., "Electrical Thermal Angioplasty: Catheter Design Features, In Vitro Tissue Ablation Studies and In Vitro Experimental Findings," <i>Am J. Cardiol</i> Vol. 60, pp. 1117-1122         |          |  |       |  |                      |
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| ___ CH   | Selikowitz & LaCourse, "Electric Current and Voltage Recordings on the Myocardium During Electrosurgical Procedures in Canines," <i>Surgery, Gynecology &amp; Obstetrics</i> , Vol. 164, 219-224, March 1987 |      |  |       |  |                      |
| ___ CI   | J. O'Malley, Schaum's Outline of Theory and Problems of Basic Circuit Analysis, McGraw-Hill, 2 <sup>nd</sup> Ed., 1992, pp. 3-5  |      |  |       |  |                      |
| ___ CJ   | Arnaud Wattiez et al., "Electrosurgery in Operative Endoscopy," <i>Electrosurgical Effects</i> , Blackwell Science, pp. 85-93, 1995  |      |  |       |  |                      |
| ___ CK   | Leslie A. Geddes, "Medical Device Accidents: With Illustrative Cases" CRC Press, 1998  |      |  |       |  |                      |
| ___ CL   | Wyeth, "Electrosurgical Unit" pp. 1181-1202  |      |  |       |  |                      |
| ___ CM   | C.P. Swain, et al., <i>Gut</i> Vol. 25, pp. 1424-1431 (1984)   |      |  |       |  |                      |
| ___ CN   | Piercey et al., <i>Gastroenterology</i> Vol. 74(3), pp. 527-534 (1978)   |      |  |       |  |                      |
| ___ CO   | A.K. Dobbie <i>Bio-Medical Engineering</i> Vol. 4, pp. 206-216 (1969)  |      |  |       |  |                      |
| ___ CP   | B. Lee et al. <i>JACC</i> Vol. 13(5), pp. 1167-1175 (1989)   |      |  |       |  |                      |
| ___ CQ   | K. Barry et al. <i>American Heart Journal</i> Vol. 117, pp. 332-341 (1982)   |      |  |       |  |                      |
| ___ CR   | W. Honig <i>IEEE</i> pp. 58-65 (1975)  |      |  |       |  |                      |
| ___ CS   | Jacob Kline, <i>Handbook of Biomedical Engineering</i> , Academic Press Inc., N.Y., pp. 98-113, 1988   |      |  |       |  |                      |
| ___ CT   | M.B. Dennis et al. "Evolution of Electrofulguration in Control of Bleeding of Experimental Gastric Ulcers," <i>Digestive Diseases and Sciences</i> , Vol. 24, No. 11, 845-848                                |      |  |       |  |                      |
| ___ CU   | Letter from Department of Health to Jerry Malis dated April 15, 1985   |      |  |       |  |                      |
| ___ CV   | Letter from Jerry Malis to FDA dated July 25, 1985   |      |  |       |  |                      |
| ___ CW   | Letter from Department of Health to Jerry Malis dated 04/22/91   |      |  |       |  |                      |
| ___ CX   | Leonard Malis, "Instrumentation for Microvascular Neurosurgery" <i>Cerebrovascular Surgery</i> , Vol 1, 245-260, 1985.   |      |  |       |  |                      |
| ___ CY   | Valleylab, Inc. "Valleylab Part Number 945 100 102 A" Surgistat Service Manual, 7/88   |      |  |       |  |                      |
| ___ Cz   | Leonard I. Malis, "New Trends in Microsurgery and Applied Technology," <i>Advanced Technology in Neurosurgery</i> , 1-16, 1988   |      |  |       |  |                      |
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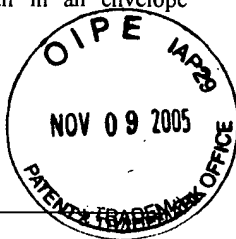
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| _____ DC   | <b>98/39038</b> | <b>9/11/98</b> | <b>WO</b>                               |       |   |                      |
| _____ DO   | <b>98/23324</b> | <b>6/4/98</b>  | <b>WO</b>                               |       |   |                      |
| _____ DP   | <b>98/19614</b> | <b>5/14/98</b> | <b>WO</b>                               |       |   |                      |
| _____ DQ   | <b>98/17186</b> | <b>4/30/98</b> | <b>WO</b>                               |       |   |                      |
| _____ DR   | <b>98/17185</b> | <b>4/30/98</b> | <b>WO</b>                               |       |   |                      |
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**PATENT**

Attorney Docket No.: C-6-2

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On

*Nov 7 2005*

By

*Michelle Nicely*

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Art Unit: 3739

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Confirmation No.: 2890

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**COMMUNICATION**

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Sir:

The following information is being brought to the Examiner's attention pursuant to 37 C.F.R. §§ 1.555, and 1.565. This is not a patent owner's statement under 37 C.F.R. § 1.530.

**I. LITIGATION ACTIVITY**

Arthrocare Corporation ("ArthroCare") commenced an action on July 25, 2001, in the United States District Court for the District of Delaware against Smith & Nephew, Inc. ("Smith & Nephew") for infringement of U.S. Patent Nos. 5,697,536 ("the '536 Patent"), 5,697,882 ("the '882 Patent") and 6,224,592 ("the '592 Patent"). That action was assigned Civil Action No. 01-504-SLR (the "*Smith & Nephew* litigation"). The *Smith & Nephew* litigation proceeded to trial commencing on April 30, 2003. On May 12, 2003, the jury returned a verdict in favor of ArthroCare on infringement and validity issues with respect to all three patents. Thereafter, on June 20, 2003, the Court entered judgment on the jury's verdict.

A number of post trial motions were filed on the issues of infringement, invalidity, and inequitable conduct. In particular, Smith & Nephew filed a motion for judgment as a matter of law; a motion for a new trial; a cross motion to strike ArthroCare's motion for entry of judgment of no inequitable conduct and a motion to modify the protective order. ArthroCare filed a motion for entry of judgment of no inequitable conduct and a motion for a permanent injunction.

On March 10, 2004 the Court ruled in favor of ArthroCare on all post trial motions. The Court issued a 90 page memorandum opinion: 1.) denying Smith & Nephew's motion for judgment as a matter of law; 2.) denying Smith & Nephew's motion for a new trial; 3.) granting ArthroCare's motion for entry of judgment of no inequitable conduct; 4.) denying Smith & Nephew's cross motion to strike ArthroCare's motion for entry of judgment of no inequitable conduct; 5.) granting ArthroCare's motion for a permanent injunction; and 6.) denying Smith & Nephew's motion to modify the protective order. The Court also issued, on March 10, 2004, a memorandum opinion granting ArthroCare's motion to dismiss Smith & Nephew's antitrust counterclaims.

On June 9, 2004, the Court issued an order enjoining Smith and Nephew from directly infringing, inducing the infringement, and contributing to the infringement of the '536 Patent, the '882 Patent and the '592 Patent. The above mentioned memorandum opinions and corresponding orders are enclosed for your consideration<sup>1</sup>.

Smith & Nephew has appealed the judgment and the injunction to the United States Court of Appeals for the Federal Circuit. The parties have completed briefing on the appeal.

On May 10, 2005, the Federal Circuit Court of Appeals issued a decision (attached) in connection with the lawsuit between ArthroCare and Smith & Nephew. In its decision, the Court, among other things, upheld the jury's verdict in favor of ArthroCare on U.S. Patent Nos. 5,697,882 and 6,224,592, but reversed the jury's verdict as to the validity of claims 46, 47, and 56 of U.S. Patent No. 5,697,536.

On May 23, 2005, Patentee filed a Combined Petition for Panel Rehearing and Rehearing *En Banc* (attached). The Petition specifies several points of law and fact overlooked or misapprehended by the Court of Appeals for the Federal Circuit in its May 10, 2005 Decision relating to the '536 Patent, the '882 Patent, and the '592 Patent. The Court issued an Order, dated July 12, 2005, denying Patentee's request for a panel rehearing and rehearing *En Banc*.

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<sup>1</sup> A portion of the memorandum opinion discussing the antitrust issues has been redacted to preserve information that is confidential



Numerous papers were filed with the Court during the *Smith & Nephew* litigation. The official docket kept by the clerk of the Delaware District Court, which is 43 pages long, is enclosed. The files holding the documents corresponding to the docket entries on the official docket span approximately eight linear feet of shelving space. Applicant is enclosing herewith the following documents from the *Smith & Nephew* litigation which show Smith & Nephew's and Applicant's primary arguments relating to issues of validity and enforceability:

1. Smith & Nephew's Supplemental Responses to Plaintiff ArthroCare's Interrogatories Nos. 4 And 5, dated December 19, 2001;
2. Smith & Nephew's Supplemental Invalidity And Infringement Contentions, served March 29, 2002<sup>2</sup>;
3. Smith & Nephew's Supplemental Invalidity Contentions, served June 3, 2002;
4. Smith & Nephew's Supplemental Invalidity Contentions, served September 10, 2002;
5. Smith & Nephew's Supplemental Invalidity Contentions, served October 9, 2002;
6. ArthroCare's Validity Contentions, served October 15, 2002;
7. Memorandum Order Re: Claim Construction, filed April 9, 2003;
8. Smith & Nephew's Notice Pursuant To 35 U.S.C. § 282;
9. Trial Testimony Of Smith & Nephew's Expert Dr. Kim Manwaring on May 6, 2003;
10. Trial Testimony Of Smith & Nephew's Expert Dr. Kenneth Taylor on May 7 & 8, 2003;
11. Jury Verdict, dated May 12, 2003;
12. Judgment In A Civil Case, filed June 20, 2003;
13. Smith & Nephew's Opening Brief In Support Of Its Inequitable Conduct Case, filed June 9, 2003;
14. Smith & Nephew's Opening Brief In Support Of Its Rule 50(b) Motion For Judgment As A Matter Of Law, filed June 30, 2003;
15. ArthroCare's Corrected Answering Brief In Opposition To Smith & Nephew's Opening Brief In Support Of Its Inequitable Conduct Case, filed July 11, 2003<sup>3</sup>;
16. ArthroCare's Answering Brief In Opposition To Smith & Nephew's Rule 50(b) Motion For Judgment As A Matter Of Law, filed July 30, 2003;

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2. Smith & Nephew marked its infringement contentions "Highly Confidential – Attorneys' Eyes Only" under the protective order. Accordingly, Applicant has secured redacted pages that omit Smith & Nephew's infringement contentions from this document.

<sup>3</sup> Smith & Nephew's Reply Brief In Support Of Its Inequitable Conduct Case, dated July 24, 2003, was filed under seal by Smith & Nephew. If the Examiner requests a copy, Applicant will contact Smith & Nephew in an attempt to secure an agreement by which the brief can be disclosed.

17. Smith & Nephew's Reply Brief In Support Of Its Rule 50(b) Motion For Judgment As A Matter Of Law, filed August 14, 2003.
18. Memorandum Opinion denying Smith & Nephew's motion to stay injunction, dated April 27, 2004, and corrected on April 28, 2004.
19. Smith & Nephew's Emergency Motion to Stay Injunction Under Fed. Cir. Rule 8, dated April 29, 2004.
20. Response of ArthroCare to Smith & Nephew's Emergency Motion to Stay Injunction Pending Appeal, dated May 6, 2004.
21. Smith & Nephew's Reply to ArthroCare's Response to Smith & Nephew's Emergency Motion to Stay Injunction Pending Appeal, dated May 12, 2004.
22. Order denying Smith & Nephew's Emergency Motion to Stay Injunction, dated June 3, 2004.
23. Order and Amended Order enjoining Smith & Nephew, dated June 9 and June 24, 2004.
24. Brief for Appellant Smith & Nephew, Inc., dated September 29, 2004.
25. Brief for Appellee ArthroCare Corp., dated November 15, 2004.
26. Reply Brief for Appellant Smith & Nephew, Inc., dated December 14, 2004.
27. Joint Appendix (3-volume set).

## II. REEXAMINATION

### A. The '536 Patent

On December 23, 1999, an *Ex Parte* Reexamination Request ("Request") for the '536 Patent was filed with the PTO. Applicant has enclosed a copy of the file history for the '536 Reexamination with this Information Disclosure Statement. The Request sought reexamination of claims 1-3, 14, 16, 22, 27, 30, 33, 38, 41-48, 55, 57, 60, and 63 of the '536 Patent in light of U.S. Patent 4,116,198 ("the Roos '198"). The PTO granted the Request on October 27, 2000.

On November 15, 2002, the PTO mailed an Office Action. The Office Action is divided into two sections. Section I sets forth the conclusion of the examiner and a board of primary examiners that "the Roos '198 does not anticipate or render obvious any of the independent claims of record." *See* November 15, 2002 Office Action at 3. Section II contains a rejection of claims 1-64 of the '536 Patent as anticipated under 35 U.S.C. § 102(b) and obvious under 35 U.S.C. § 103 in light of certain references

identified in an Information Disclosure Statement filed by Applicant on June 19, 2002. On December 19, 2002, Applicant submitted a Response to the Office Action.

On March 14, 2003, the PTO issued a Notice of Intent to Issue *Ex Parte* Reexamination Certificate ("NIRC"). The NIRC states that "the examiner of record concurs with the arguments presented by patent Applicant on paper number 15. Accordingly, it is concluded that claims 1-64 are allowable over the prior art of record." See NIRC at 2. A Reexamination Certificate issued on June 10, 2003.

Additionally, on April 9, 2003, another *Ex Parte* Reexamination Request for the '536 Patent was filed with the PTO. The Request sought reexamination of claims 1, 2, 5, 9, 14, 15, 25, 26, 28, 30-33, 36, 38, 40, 42-47, 49, 53, 55, 56, 58, 59, 61, and 63 of the '536 Patent in light of the Roos '198; Elsasser and Roos, "Uber ein Instrument zur leckstromfreien transurethralen resection," Medizinal-Markt/Acto Medico technica, Vol. 24, No. 4/1976, pp. 129-134 ("the Elsasser and Roos article"); U.S. Patent Nos. 4,805,616; 4,674,499; 4,381,007; 5,217,459; and 5,007,908. The PTO granted the Request on June 30, 2003. It has been assigned Reexamination No. 90/006,597.

A non-final office action was issued on November 19, 2004. Patentee submitted a timely reply on January 18, 2005.

B. The '882 Patent

On April 18, 2003, an *Ex Parte* Reexamination Request for the '882 Patent was filed with the PTO. The Request sought reexamination of claims 1, 13, 17, 18, 24, 26, 28, 29, 48 and 54 of the '882 Patent in light of U.S. Patent Nos. 5,122,138; 5,007,908; and Slager et al., "Vaporization Of Atherosclerotic Plaques By Spark Erosion," JACC Vol. 5, No. 6, June 1985:1382-6 ("the Slager Article"). The PTO granted the Request on July 1, 2003. It has been assigned Reexamination No. 90/006,607. An Office Action issued on February 18, 2005. Applicant filed a timely reply on April 18, 2005.

C. The '592 Patent

On April 21, 2003, an *Ex Parte* Reexamination Request for the '592 Patent was filed with the PTO. The Request sought reexamination of claims 1, 3, 4, 9, 11, 21, 23, 26, 27, 30, 32 and 42 of the '592 Patent in light of the Roos '198; the Elsasser and Roos article; U.S. Pat. Nos. 4,381,007 to Doss; and the Slager Article. The PTO granted the Request on July 7, 2003. It has been assigned Reexamination No.

90/006,611. An Office Action issued on April 14, 2005 and April 26, 2005. Applicant filed a timely reply on June 27 2005.

Should the Examiner desire copies of any of the documents filed in connection with the above reexaminations Applicant will submit them upon a request to do so in writing from the Examiner.

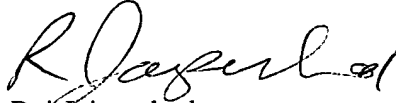
## III. COPENING APPLICATIONS

Applicant also brings to the Patent Office's attention the following co owned, co-pending patent applications:

| Application No. | Filing Date | Application No. | Filing Date |
|-----------------|-------------|-----------------|-------------|
| 09/293,231      | 16-Apr-1999 | 10/621,839      | 16-Jul-2003 |
| 09/314,247      | 18-May-1999 | 10/437,260      | 13-May-2003 |
| 09/338,842      | 23-Jun-1999 | 10/402,728      | 28-Mar-2003 |
| 09/347,390      | 06-Jul-1999 | 10/392,529      | 20-Mar-2003 |
| 09/354,835      | 16-Jul-1999 | 10/389,159      | 14-Mar-2003 |
| 09/372,454      | 11-Aug-1999 | 10/613,609      | 02-Jul-2003 |
| 09/457,201      | 06-Dec-1999 | 10/435,825      | 12-May-2003 |
|                 |             | 10/613,115      | 03-Jul-2003 |
| 09/501,327      | 09-Feb-2000 | 10/621,839      | 16-Jul-2003 |
| 09/512,742      | 24-Feb-2000 | 10/661,118      | 12-Sep-2003 |
| 09/562,496      | 01-May-2000 | 10/656,597      | 05-Sep-2003 |
| 09/586,295      | 02-Jun-2000 | 10/682,600      | 09-Oct-2003 |
| 09/679,394      | 03-Oct-2000 | 10/713,643      | 13-Nov-2003 |
| 09/747,311      | 20-Dec-2000 | 10/735,477      | 11-Dec-2003 |
| 09/796,094      | 28-Feb-2001 | 10/774,222      | 05-Feb-2004 |
| 09/839,427      | 20-Apr-2001 | 10/799,908      | 12-Mar-2004 |
| 09/963,736      | 03-May-2001 | 10/799,491      | 12-Mar-2004 |
|                 |             | 10/903,655      | 29-Jul-2004 |
| 10/072,599      | 05-Feb-2002 | 10/970,796      | 20-Oct-2004 |
| 10/097,763      | 13-Mar-2002 |                 |             |
| 10/139,117      | 03-May-2002 | 11/028,790      | 03-Jan-2005 |
| 10/187,733      | 27-Jun-2002 | 11/089,879      | 25-Mar-2005 |
| 10/264,308      | 02-Oct-2002 | 11/105,274      | 12-Apr-2005 |
| 10/288,227      | 04-Nov-2002 | 11/114,610      | 25-Apr-2005 |
| 10/290,930      | 07-Nov-2002 | 11/125,613      | 09-Mar-2005 |
| 10/290,930      | 07-Nov-2002 | 11/130,931      | 16-May-2005 |
| 10/291,213      | 08-Nov-2002 | 11/144,934      | 03-Jun-2005 |
|                 |             | 11/166,545      | 24-Jun-2005 |
| 10/339,470      | 09-Jan-2003 | 11/176,803      | 06-Jul-2005 |
| 10/367,608      | 13-Feb-2003 |                 |             |
| 10/372,591      | 21-Feb-2003 |                 |             |
| 10/374,411      | 25-Feb-2003 |                 |             |
| 10/384,050      | 05-Mar-2003 |                 |             |
| 10/389,159      | 13-Mar-2003 |                 |             |

Should the Examiner desire any of the documents mentioned above or in the previously submitted Communication that have not been provided to the Examiner, ArthroCare shall supply them upon the Examiner's request in writing.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Jaipershad', with a stylized flourish at the end.

Raj Jaipershad  
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